

RECEIVED
CENTRAL FAX CENTER



Pitney Bowes Inc. **SEP 17 2007**

Senior Corporate Counsel
Intellectual Property & Technology Law
35 Waterview Drive
P.O. Box 3000
Shelton, CT 06484-8000
203-924-3180
203-924-3919 Fax
George.Macdonald@pb.com
www.pitneybowes.com

Facsimile

To: Mail Stop AF
Examiner Jonathan C. Schaffer, GAU: 2624
Fax No.: (571) 273-8300
From: George M. Macdonald
Date: July 16, 2007
Subject: Serial No.: 10/065,285
Pages: 18 (including this cover)

Re: U.S. Patent Application Serial No.: 10/065,285
Confirmation No.: 5700
Our Docket # F-560


CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that the following correspondence is being transmitted
via facsimile to:

Patent and Trademark Office
Attention: Examiner Jonathan C. Schaffer, GAU: 2624
Facsimile No. (571) 273-8300

1. Appellants' Brief on Appeal (17 pages).

on September 17, 2007
Date of Transmission


Signature

George M. Macdonald
Name of Registered Rep.
Reg. No.: 39,284

September 17, 2007
Date

Serial No.: 10/065,285
Attorney Docket No.: F-560

Patent

RECEIVED
CENTRAL FAX CENTER

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

SEP 17 2007

In re patent application of:) Attorney Docket No.: F-560
John F. Braun, et al.) Customer No.: 00919
Serial No.: 10/065,285)
Filed: September 30, 2002) Examiner: Schaffer, Jonathan C.
Confirmation # 5700) Group Art Unit: 2621
Date: September 17, 2007

Title: METHOD AND SYSTEM FOR IDENTIFYING A PAPER FORM USING
A DIGITAL PEN

Mail Stop Appeal Brief- Patents
Commissioner for Patents
Alexandria, VA 22313-1450

APPELLANTS' BRIEF ON APPEAL

Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 41.31 et seq. from the final rejection of claims 1-5, 7-15, 17 and 20-24 of the above-identified application mailed April 16, 2007. This Brief is in furtherance of the Notice of Appeal transmitted in this case on July 16, 2007. Accordingly, this brief is timely filed. The fee for submitting this Brief is \$500.00 (37 C.F.R. § 1.17(c)). Please charge Deposit Account No. 16-1885 in the amount of \$500.00 to cover these fees. The Commissioner is hereby authorized to charge any additional fees that may be required for this appeal or to make this brief timely or credit any overpayment to Deposit Account No. 16-1885.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, on September 17, 2007 (Date of Transmission). George M. Macdonald, Reg. No. 39,284 (Name of Registered Rep.)

 (Signature)

September 17, 2007 (Date)

09/20/2007 EHAILE1 00000004 161885 10065285

(10073093.1)

1/17

01 EC:1482 500.00 DA
September 17, 2007 Appellants' Appeal Brief

Serial No.: 10/065,285
Attorney Docket No.: F-560

Patent

RECEIVED
CENTRAL FAX CENTER
SEP 17 2007

TABLE OF CONTENTS

- I Real Party in Interest**
- II Related Appeals and Interferences**
- III Status of Claims**
- IV Status of Amendments**
- V Summary of Claimed Subject Matter**
- VI Grounds of Rejection to Be Reviewed on Appeal**
- VII Argument**
- VIII Claims Appendix**
- IX Evidence Appendix - None.**
- X Related Proceedings Appendix – None.**

Serial No.: 10/065,285
Attorney Docket No.: F-560

Patent

I. Real Party in Interest

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

II. Related Appeals and Interferences

There are no appeals or interferences known to Appellant, his legal representative, or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 1-5, 7-15, 17 and 20-24 are in the case and under final rejection of the Examiner.

Claims 6, 16 and 18-19 are canceled without prejudice or disclaimer.

Claims 1, 9, 17 and 20 [sic, claim 24 incorrectly listed here in rejection] are in the case and under final rejection of the Examiner and stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,456,740 to Carini, et al. ("Carini '740").

Claims 2-5, 7-8, 10-15 and 21-24 [sic, claim 6 incorrectly listed here in rejection] are in the case and under final rejection of the Examiner and stand rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent No. 6,456,740 to Carini, et al. ("Carini '740") in view of U.S. Patent No. 6,618,040 to Mattaway, et al. ("Mattaway '040").

Appellants hereby appeal the final rejection of claims 1-5, 7-15, 17 and 20-24.

IV. Status of Amendments

There are no amendments to the claims filed subsequently to the Final Office Action of April 16, 2007. Therefore, the claims set forth in Appendix A to this brief are those as set forth before the final rejection.

V. Summary of Claimed Subject Matter

Serial No.: 10/065,285
 Attorney Docket No.: F-560

Patent

Appellants' invention as presently claimed relates generally to systems and methods for identifying a digital form template using a pointing device such as a digital pen and for ensuring that a user has the authority to use a particular form. See Specification at ¶¶ 0005, 0010-0012 and 0051.

An illustrative embodiment is described with reference to FIG. 1A using an Auto Loan application form 100. The form includes a pre-printed identifier 110 that is dashed for a user to trace. The form also includes a signature box 126. See Specification at ¶¶ 0031-0045.

100 →

102 AUTO LOAN APPLICATION		
112 PLEASE TRACE OVER THE NUMBER IN THE BOX TO THE RIGHT		111 KJ302ED
114 APPLICANT NAME		118 ADDRESS
116 SOCIAL SECURITY NUMBER	122 STATE	120 ZIP CODE
126		124
108 APPLICANT SIGNATURE		104 DATE

FIG. 1A

Independent claim 1 recites:

1. A method for processing form input data comprising:
 capturing user stroke data from a form including strokes made by a user with a pointing device by tracing over at least one form identifier character that is pre-printed on the form;

Serial No.: 10/065,285
Attorney Docket No.: F-560

Patent

processing the strokes in order to determine form identification data;
receiving user identification data;
retrieving a form template using the form identification data;
determining if the user is authorized to use the form template; and
processing the form input data using the form template if the user is authorized to use the form template.

Certain illustrative systems and methods for identifying a digital form template use a digital pen for tracing over pre-printed characters used as a form identifier. The back-end system then uses that pen stroke data to identify the form. See, e.g., FIG. 1A and Specification at ¶¶ 0005, 0010-0012. The system is configured to process the stroke data to determine the form template. See, e.g., FIG. 3 and specification at ¶ 49. The system then may determine if an authorized salesman is using the auto loan application. See Specification at ¶ 0051.

Independent claim 24 recites:

24. A method for processing form input data comprising:
capturing user stroke data from a form including strokes made by a user with a digital pen on a digital paper form;
processing the strokes in order to determine a subset of the user strokes consisting of form identification data by searching the stroke data for predetermined symbols associated with form identification data;
retrieving a form template using the form identification data; and
processing the form input data using the form template, wherein the subset of strokes is not located in a fixed location on the digital paper form.

Similarly, in another illustrative embodiment, the system captures digital pen strokes, processes the strokes, retrieves a form template and processes the input data, but wherein the strokes related to the form identification data is not located in a fixed location on the digital paper form. See Specification at ¶ 0049.

Independent claim 9 recites:

9. A system for processing form input data comprising:
a processor;
a storage device connected to the processor;
the storage device storing a logic program;

Serial No.: 10/065,285
Attorney Docket No.: F-560

Patent

the processor operative with the logic program to perform:
capturing user stroke data relating to strokes made by a user with a pointing device corresponding to at least one form identifier character that is pre-printed on the form;
processing the strokes in order to determine form identification data;
receiving user identification data;
retrieving a form template using the form identification data;
determining if the user is authorized to use the form template; and
processing the form input data using the form template if the user is authorized to use the form template.

Certain illustrative systems and methods for identifying a digital form template use a digital pen for tracing over pre-printed characters used as a form identifier. The back-end system then uses that pen stroke data to identify the form. See, e.g., FIG. 1A and Specification at ¶¶ 0005, 0010-0012. The system is configured to process the stroke data to determine the form template. See, e.g., FIG. 3 and specification at ¶ 49. The system then may determine if an authorized salesman is using the auto loan application. See Specification at ¶ 0051.

Additional features of the invention are discussed below in the Argument section of this Brief. This summary is not intended to supplant the description of the claimed subject matter as provided in the claims as recited in Appendix A, as understood in light of the entire specification.

VI. Grounds of Rejection to Be Reviewed on Appeal

Whether claims 1, 9, 17 and 20 [sic, claim 24 incorrectly listed here in rejection] are patentable under 35 U.S.C. §102(e).

Whether claims 2-5, 7-8, 10-15 and 21-24 [sic, claim 6 incorrectly listed here in rejection] are patentable under 35 U.S.C. §103(a).

VII. Argument

Serial No.: 10/065,285
Attorney Docket No.: F-560

Patent

As discussed in detail below, Appellants respectfully submit that the final rejection of claims 1-5, 7-15, 17 and 20-24 does not meet the threshold burden of presenting a prima facie case of unpatentability. Accordingly, Appellants are entitled to grant of those claims. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

A Claims 1, 9, 17 and 20 are not Unpatentable under 35 U.S.C. § 102(e)

Claims 1, 9, 17 and 20 [sic, claim 24 incorrectly listed here in rejection] are in the case and stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,456,740 to Carini, et al. ("Carini '740").

Appellants respectfully disagree with the rejection and urge its reversal for at least the reasons stated below.

To establish anticipation of the claims under § 102(b), the Examiner is required to show that every element or step of the claim is found in a single reference. "To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." PPG Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558, 1566, 37 U.S.P.Q.2D (BNA) 1618, 1624 (Fed. Cir. 1996).

Independent claim 1 recites:

1. A method for processing form input data comprising:
capturing user stroke data from a form including strokes made by a user with a pointing device by tracing over at least one form identifier character that is pre-printed on the form;
processing the strokes in order to determine form identification data;
receiving user identification data;
retrieving a form template using the form identification data;
determining if the user is authorized to use the form template; and
processing the form input data using the form template if the user is authorized to use the form template. (emphasis added)

The Examiner relies upon Carini '740 to teach restricting processing upon determination of an authorized user as claimed above citing the following passage:

A form generator can produce forms which are customized for a particular individual, such as a customer. The generator can assign a

Serial No.: 10/065,285
Attorney Docket No.: F-560

Patent

form identifier for the customized form which contains an individual's identification number, such as a customer number, as part of the form identifier, as described above with reference to FIG. 6C. Carini '740, Col. 9, lines 49-54.

However, Appellants respectfully submit that Carini '740 merely teaches generating a customized form – not ensuring that the intended individual is actually using the form. There is no teaching or suggestion in Carini '740 of any determination of whether a particular user is authorized to use the form and for thereby restricting access. In the system of Carini '740, Appellants respectfully submit that anyone could use that custom form.

Accordingly, Appellants respectfully submit that the Examiner has failed to establish a prima facie case for an anticipation rejection of claim 1. Similarly, Appellants respectfully submit that independent claim 9 contains similar limitations and is patentable over the cited reference for at least the same reasons described with reference to claim 1. Additionally, Appellants respectfully submit that dependent claims 17 and 20 are patentable over the cited reference for at least the same reasons discussed with reference to the applicable independent claim and any intervening claims.

Appellants respectfully submit that claims 1, 9, 17 and 20 are patentable over the cited reference and that the final rejection is in error and should be reversed.

B Claims 2-5, 7-8, 10-15 and 21-24 are not Unpatentable under 35 U.S.C. § 103(a)

Claims 2-5, 7-8, 10-15 and 21-24 [sic, claim 6 incorrectly listed here in rejection] are in the case and stand rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent No. 6,456,740 to Carini, et al. ("Carini '740") in view of U.S. Patent No. 6,618,040 to Mattaway, et al. ("Mattaway '040").

Appellants respectfully disagree with the rejection and urge its reversal for at least the reasons stated below.

Serial No.: 10/065,285
Attorney Docket No.: F-560

Patent

In rejecting a claim under 35 U.S.C. §103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 375 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention. *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995); *In re Deuel*, 51 F.3d 1552, 34 USPQ 1210 (Fed. Cir. 1995); *In re Fritch*, 972 F.2d 1260, 23 USPQ 1780 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). See *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___, 127 S.Ct. 1727, 1735 (2007).

Initially, Appellants respectfully submit that Mattaway '040 does not deal with a problem of locating a form template and thus one of skill in the art would not be motivated to modify Carini '740 using Mattaway '040.

Furthermore, Appellants respectfully submit that dependent claims 2-8, 10-15 and 21-23 are patentable over the cited references for at least the same reasons discussed above with reference to the applicable independent claim and any intervening claims.

Furthermore, with regard to dependent claims 5 and 13, Appellants respectfully resubmit that the references do not teach or suggest:

5. The method of claim 4 wherein:
the pre-determined criteria includes font criteria. (emphasis added).

Appellants respectfully submit that the cited portion of Carini at Col. 6, line 34 does not teach character height as suggested, but merely describes the exemplary size of an input box, not in any way describing font characteristics.

Furthermore, with regard to claim 7, Appellants respectfully dispute the statement of official notice to the extent that it is intended to take notice of more than the limited notion of prior use of serialized paper forms such as receipts and also respectfully dispute the combination suggested. There does not appear to be any teaching or suggestion in Carini '740 of individually serialized forms.

Serial No.: 10/065,285
Attorney Docket No.: F-560

Patent

Regarding claim 11, Appellants respectfully submit that it does not appear that the cited references describe using control string characters.

Regarding claims 21 and 23, Appellants respectfully resubmit that the references do not teach or suggest:

21. The method of claim 2, wherein:
the user identification data includes pen stroke data. (emphasis added).

The Examiner relies upon Carini '740 to teach restricting processing upon determination of an authorized user as claimed above citing the following passage:

The electronic stroke data corresponds to a unique form identifier which in turn corresponds to a given one of the plurality of different types of form. The forms processing component is configured to receive the electronic stroke data, recognize the unique form identifier, and communicate the unique form identifier to the form description repository. The forms processing component is further configured to receive a form definition, corresponding to the unique form identifier, from the form description repository, and to correctly process the electronic entry field data based thereon.

There is nothing in the cited passage to suggest user identification data that includes pen stroke data.

Furthermore, with regard to claim 22, Appellants respectfully dispute the statement of official notice to the extent that it is intended to take notice of more than the limited notion of a peripheral device communicating its type to facilitate its use.

Independent claim 24 recites:

24. A method for processing form input data comprising:
capturing user stroke data from a form including strokes made by a user with a digital pen on a digital paper form;
processing the strokes in order to determine a subset of the user strokes consisting of form identification data by searching the stroke data for predetermined symbols associated with form identification data;
retrieving a form template using the form identification data; and
processing the form input data using the form template, wherein the subset of strokes is not located in a fixed location on the digital paper form. (emphasis added).

{0073093.1}
Brief

10/17 September 17, 2007 Appellants' Appeal

Serial No.: 10/065,285
Attorney Docket No.: F-560

Patent

Appellants respectfully submit that the cited references do not teach or suggest wherein the subset of strokes is not located in a fixed location on the digital paper form. As apparently admitted by the Examiner, at page 12 of the Final Rejection, Carini '740 requires that the form had fixed locations, although it appears that location could vary from form to form.

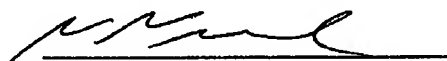
Accordingly, Appellants respectfully submit that the Examiner has failed to establish a prima facie case for an obviousness rejection. Appellants respectfully submit that claims 2-5, 7-8, 10-15 and 21-24 are patentable over the available cited references and that the final rejection is in error and should be reversed.

For at least the above stated reasons, Appellants respectfully submit that the final rejection as to claims 2-5, 7-8, 10-15 and 21-24 is in error and should be reversed.

IX. Conclusion

In Conclusion, Appellants respectfully submit that the final rejection of claims 1-5, 7-15, 17 and 20-24 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,



George M. Macdonald
Reg. No. 39,284
Attorney for Appellants
Telephone (203) 924-3180

PITNEY BOWES INC.
Intellectual Property and Technology Law Department
35 Waterview Drive, P.O. Box 3000
Shelton, CT 06484-8000

Serial No.: 10/065,285
Attorney Docket No.: F-560

Patent

RECEIVED
CENTRAL FAX CENTER

SEP 17 2007

VIII – CLAIMS APPENDIX
APPENDIX A

1. A method for processing form input data comprising:
capturing user stroke data from a form including strokes made by a user with a pointing device by tracing over at least one form identifier character that is pre-printed on the form;
processing the strokes in order to determine form identification data;
receiving user identification data;
retrieving a form template using the form identification data;
determining if the user is authorized to use the form template; and
processing the form input data using the form template if the user is authorized to use the form template.
2. The method of claim 1 wherein the pointing instrument is a digital pen and strokes are provided by the user writing on a paper form.
3. The method of claim 2 further comprising:
processing a pre-determined portion of the stroke data corresponding to at least one control string character to determine the form identification data; and
receiving user pen stroke data from at least one data field of the form before processing the strokes in order to determine the form identification data.
4. The method of claim 2 wherein:
processing stroke data that satisfies pre-determined criteria to determine the form identification data.
5. The method of claim 4 wherein:
the pre-determined criteria includes font criteria.

Serial No.: 10/065,285
Attorney Docket No.: F-560

Patent

7. The method of claim 2 wherein the form identification data includes a form serial number printed on the form, wherein the form serial number identifies a particular instance of a use of a form template.

8. The method of claim 7 wherein the form serial number printed on the form includes a dashed font.

9. A system for processing form input data comprising:
a processor;
a storage device connected to the processor;
the storage device storing a logic program;
the processor operative with the logic program to perform:
capturing user stroke data relating to strokes made by a user with a pointing device corresponding to at least one form identifier character that is pre-printed on the form;
processing the strokes in order to determine form identification data;
receiving user identification data;
retrieving a form template using the form identification data;
determining if the user is authorized to use the form template; and
processing the form input data using the form template if the user is authorized to use the form template.

10. The system of claim 9 wherein the pointing instrument is a digital pen and strokes are provided by the user writing on a paper form.

11. The system of claim 10 further comprising the processor operative with the logic program to perform:
processing a pre-determined portion of the stroke data corresponding to at least one control string character to determine the form identification data; and

Serial No.: 10/065,285
Attorney Docket No.: F-560

Patent

receiving user pen stroke data from at least one data field of the form before processing the strokes in order to determine the form identification data.

12. The system of claim 10 further comprising the processor operative with the logic program to perform:

processing stroke data that satisfies pre-determined criteria to determine the form identification data.

13. The system of claim 12 wherein:
the pre-determined criteria includes font criteria.

14. The system of claim 11 wherein:
the pre-determined portion of the stroke data is related to a pre-determined physical portion of the form; and
the form identification data includes a form serial number printed on the form.

15. The system of claim 14 wherein the form serial number printed on the form includes a dashed font.

17. The method of claim 1 further comprising:
processing the strokes in order to determine a unique instance data identifier for the particular form.

20. The system of claim 9 further comprising the processor operative with the logic program to perform:
processing the strokes in order to determine a unique instance data identifier for the particular form, and wherein
the character set includes non-alphanumeric characters.

21. The method of claim 2, wherein:
the user identification data includes pen stroke data.

Serial No.: 10/065,285
Attorney Docket No.: F-560

Patent

22. The method of claim 2, wherein:
the user identification data includes pen identification data.

23. The system of claim 10, wherein:
the user identification data includes pen stroke data and pen identification data.

24. A method for processing form input data comprising:
capturing user stroke data from a form including strokes made by a user with a digital pen on a digital paper form;
processing the strokes in order to determine a subset of the user strokes consisting of form identification data by searching the stroke data for predetermined symbols associated with form identification data;
retrieving a form template using the form identification data; and
processing the form input data using the form template, wherein the subset of strokes is not located in a fixed location on the digital paper form.

Serial No.: 10/065,285
Attorney Docket No.: F-560

Patent

Appendix IX – Evidence Appendix

None

Serial No.: 10/065,285
Attorney Docket No.: F-560

Patent

Appendix X – Related Proceedings Appendix

None

{0073093.1}
Brief

17/17 September 17, 2007 Appellants' Appeal